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In re Application of: :
Ekberg et al. :
Serial No.: 10/575,701 : PETITION DECISION
Filed: December 11, 2006 :
Attorney Docket No.: CBX0007-506-US :

This is in response to the petition under 37 CFR § 1.181, filed February 11, 2010, requesting that the finality of the Office action of December 11, 2009 be withdrawn.

BACKGROUND

The examiner mailed a non-final Office action on June 18, 2009 setting a three month statutory limit for reply. At the time of this non-final Office action, claims 3 and 10-15 were pending. The examiner rejected claim 14 under 35 USC 112, second paragraph, as indefinite. Claims 3, 10, 13 and 15 were rejected under 35 USC 103 (a) as being unpatentable over Ido et al. Claim 12 was rejected under 35 USC 103 (a) as being unpatentable over Ido et al. as applied to claims 3, 10, 13 and 15 above, and further in view of Johansson et al. Claim 11 was rejected under 35 USC 103 (a) as being unpatentable over Ido et al. as applied to claims 3, 10, 13 and 15 above, and further in view of Wahren et al. and Johansson et al.

In reply to the non-final Office action of June 18, 2009, applicants filed a response on September 18, 2009. The response submitted by applicants included remarks, arguments traversing the rejections made in the non-final Office action and amendments to the claims.

On December 11, 2009, the examiner mailed a final Office action setting a three month statutory limit for reply. At the time of this final Office action, claims 3 and 10-15 were pending. Claims 3, 10 and 12-15 were rejected under 35 USC 102 (b) as anticipated by Johansson et al. Claim 11 was rejected under 35 USC 103 (a) as being unpatentable over Johansson et al. as applied to claims 3, 10 and 12-15 above, and further in view of Wahren et al.

In response thereto, applicants filed this petition on February 11, 2010, requesting that the finality of the Office action of December 11, 2009 be withdrawn.

DISCUSSION

The petition and the file history have been carefully considered.

In the petition filed by applicants on February 11, 2010, applicants request that the finality of the Office action of December 11, 2009 be withdrawn as improper. Applicants argue "The new grounds of rejection were not necessitated by the present amendment because (i) with respect to claims 3, 10 and 12-15 the amendments merely clarify the claimed subject matter and do not introduce any new claim elements that are substantially different from those previously presented, and (ii) with respect to claim 11, the claim was not amended."

Specifically, applicants argue "the current amendment to claim 3 clarifies only the form of the claim and does not substantially change its scope. In particular the current amendment effectively replaces the term "once daily dose" with the term "once daily administration". Applicants note that the instant specification (paragraph [0025] of US application 10/575,701), defines these terms identically. Thus the amended claim is substantially the same scope as the previously pending claim, and the Applicant's amendment cannot have necessitated the new art rejection."

Applicants' arguments are well taken and persuasive since applicants' amendments did not necessitate the new rejection. As noted by applicants, MPEP § 706.07 recites:

Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p).

Furthermore, a second or any subsequent action on the merits in any application or patent undergoing reexamination proceedings will not be made final if it includes a rejection, on newly cited art, other than information submitted in an information disclosure statement filed under 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p), of any claim not amended by applicant or patent owner in spite of the fact that other claims may have been amended to require newly cited art.

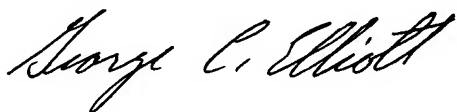
Thus, it is *not* proper for an office action to be made final when the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c). Accordingly, it is decided that Applicants' arguments are well-taken and found persuasive.

DECISION

The petition is **GRANTED**.

The Office action mailed December 11, 2009 is hereby vacated to the extent that it was made "final" and the Office action is now considered to be a non-final Office action. The after final amendment of February 11, 2010 will also be entered. This application will be forwarded to the examiner to take an action consistent with the decision herein.

Should there be any questions about this decision please contact Marianne C. Seidel, by letter addressed to Director, TC 1600, at the address listed above, or by telephone at 571-272-0584 or by facsimile sent to the general Office facsimile number, 703-872-9306.

A handwritten signature in cursive script, reading "George C. Elliott".

George Elliott
Director, Technology Center 1600